

Notice of Allowability

Application No.

09/532,514

Examiner

Fred Ferris

Applicant(s)

KUDO ET AL.

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 30 April 2004.
2. ☒ The allowed claim(s) is/are 1-4,6-23 and 26-28.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date 18.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 5-26-04
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. *This Office Action is in response to applicant's amendment filed 30 April 2004. Claims 1-4, 6-23 and 26-28 are currently pending in this application. Claims 1-4, and 6-18 were previously allowed. Claims 5, 24, and 25 have been cancelled by applicants. Amended claims 19-23 and 26-28 have now been allowed over the prior art of record.*

Response to Arguments

2. *Applicant's arguments filed on 30 April 2004 have been fully considered and found to be persuasive.*

Regarding applicant's response to 112(2) rejections: *The examiner withdraws the 112(2) rejection in view of applicant's amendment to claim 19.*

Regarding applicant's response to 102/103 prior art prior art rejections:
Applicants have amended independent claims 19 and 20 to distinguish the claimed invention over the prior art of record. (See interview summary dated 26 May 2004) Accordingly, the examiner withdraws the 102/103 prior art prior rejection of claims 19-23 and 26-28 in view of applicant's amendment to independent claims 19 and 20 and interview summary dated 26 May 2004.

Allowable Subject Matter

3. *Claims 1-4, 6-18, 19-23 and 26-28 are allowed over the prior art of record.*

The following is an examiners statement of reasons allowance:

Per claims 1-4, and 6-18: Independent claim 1 uses "means for" language and is given deference in view of *In re Donaldson* and interpreted in view of 35 U.S.C. § 112 paragraph 6. The "means for" language and the limitations (bus control means and memory control means) related thereto of claim 1 are interpreted within the scope of enablement as provided within the relative embodiment provided within applicant's specification. Specifically, independent claim 1 recites a bus control "means for" and memory control "means for" that are described by the specification in passages beginning on page 10, line 2, and page 14, line 19 respectively. The examiner has therefore interpreted the specific bus control means, memory control means, and associated external terminal connections as specifically disclosed in applicant's specification on page 10, line 2 to page 11, line 10 (bus control), page 11, line 15 to page 12, line 9 (terminal connection), page 14, line 19 to page 15, line 8 (memory control), and page 23, lines 15-27 (memory control). Claims 2-4, and 6-18 are allowable as being dependent from claim 1.

Per claims 19-23 and 26-28: Independent claims 19 and 20 claim limitations relating to an emulation method and microcomputer for executing processor instructions, sending external signals, outputting control signals by a memory controller, connecting processor bus by a bus controller, sharing an emulation memory, and an external terminal connection. This has been disclosed in the prior art. The prior art of record, while disclosing these features does not meet the conditions as suggested in MPEP section 2132, namely:

*"The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an **ipsissimis verbis** test, i.e., identity of terminology is not required. **In re Bond**, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."*

In particular, the prior art of record does not disclose (see claim 19, for example) features pertaining to the specific operation of the bus controller, memory controller, and associated external terminal connections as specifically disclosed in applicant's specification on page 10, line 2 to page 11, line 10 (bus control), page 11, line 15 to page 12, line 9 (terminal connection), page 14, line 19 to page 15, line 8 (memory control), and page 23, lines 15-27 (memory control), in the context of the claims. (also see interview summary dated 26 May 2004) Claims 21-23, and 26-28 are allowable as being dependent from independent claim 20.

The closest prior art uncovered during examination is:

*U.S. Patent 6,240,377 issued to Kai et al
U.S. Patent 5,313,618 issued to Pawlowski
U.S. Patent 5,623,673 issued to Gephardt et al
U.S. Patent 4,939,637 issued to Pawlowski*

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

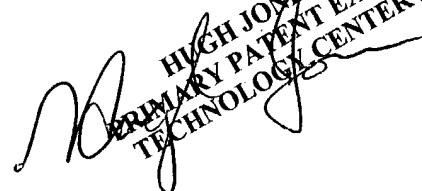
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Ferris whose telephone number is 703-305-9670 and whose normal working hours are 8:30am to 5:00pm Monday to Friday.

Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist whose telephone number is 703-305-3900.

The Official Fax Numbers are:

Official (703) 872-9306

Fred Ferris, Patent Examiner
Simulation and Emulation, Art Unit 2128
U.S. Patent and Trademark Office
Crystal Park 2, Room 2A22
Crystal City, Virginia 22202
Phone: (703) 305 - 9670
FAX: (703) 305 - 7240
Fred.Ferris@uspto.gov
May 27, 2004


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100